

## SOLICITOR

AO 120 (Rev. 2/99)

AUG 1 2008

TO: Mail Stop 8  
 Director of the U.S. Patent & Trademark Office  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

U.S. PATENT &amp; TRADEMARK OFFICE

REPORT ON THE  
FILING OR DETERMINATION OF AN  
ACTION REGARDING A PATENT OR  
TRADEMARK

In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Northern District of California on the following  Patents or  Trademarks:

DOCKET NO. <b>CV 08-03726 EMC</b>	DATE FILED <b>8/4/08</b>	U.S. DISTRICT COURT <b>450 Golden Gate Avenue, P.O. Box 36060, San Francisco, CA 94102</b>
PLAINTIFF <b>ADVANCED SEMICONDUCTOR ENGINEERING, ET AL.</b>	DEFENDANT <b>TESSERA, INC.</b>	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 see Complaint		
2 <u>5,663,106</u>		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		
3		
4		
5		

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
--------------------

CLERK Richard W. Wicking	(BY) DEPUTY CLERK Sheila Rash	DATE August 5, 2008
-----------------------------	----------------------------------	------------------------

Copy 1—Upon initiation of action, mail this copy to Commissioner    Copy 3—Upon termination of action, mail this copy to Commissioner  
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner    Copy 4—Case file copy

1 ROBERT E. CAMORS, JR., CA BAR NO. 121204  
2 [bocamors@thelen.com](mailto:bocamors@thelen.com)

2 PAPOOL S. CHAUDHARI, CA BAR NO. 241346  
3 [pchaudhari@thelen.com](mailto:pchaudhari@thelen.com)

3 THELEN REID BROWN RAYSMAN & STEINER LLP  
4 225 West Santa Clara, 12th Floor  
5 San Jose, California 95113-1723  
Telephone: (408) 292-5800  
Facsimile: (408) 287-8040

6 Attorneys for Plaintiffs  
ADVANCED SEMICONDUCTOR ENGINEERING, INC., ASE TEST LIMITED, and ASE  
7 (U.S.), INC.

ADR  
8 UNITED STATES DISTRICT COURT  
9 NORTHERN DISTRICT OF CALIFORNIA

10 ADVANCED SEMICONDUCTOR ENGINEERING,  
INC., ASE TEST LIMITED, and ASE (U.S.) INC,

C Case No.: 08 03726

11 Plaintiffs,  
12 vs.  
13 TESSERA, INC.,  
14 Defendants.

EMC  
COMPLAINT FOR  
DECLARATORY JUDGMENT  
OF NON-INFRINGEMENT AND  
INVALIDITY OF U.S. PATENT  
NO. 5,663,106

DEMAND FOR JURY TRIAL

15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

## **COMPLAINT**

Plaintiffs Advanced Semiconductor Engineering, Inc., ASE Test Limited, and ASE (U.S.) Inc. (collectively “ASE”) for its Complaint against Tessera, Inc. (“Tessera”) herein allege:

### NATURE OF ACTION

1. This is an action for declaratory relief arising under the Patent Act of the United States, 35 U.S.C. §100 et. seq., regarding non-infringement and invalidity of United States Patent No. 5,663,106 ("'106 Patent"). A copy of the '106 Patent is attached hereto as Exhibit A.

## **PARTIES**

9                   2. Advanced Semiconductor Engineering, Inc. is a corporation organized  
10 under the laws of Taiwan, Republic of China, and has a principal place of business at 26 Chin  
11 Third Road, Nantze Export Processing Zone, Kaohsiung, Republic of China.

12           3. ASE Test Limited is a corporation organized under the laws of Taiwan,  
13 Republic of China, and has a principal place of business at 10 West Fifth Street, Nantze Export  
14 Processing Zone, Kaohsiung, Republic of China.

15                  4. ASE (U.S.) Inc. is a California corporation and has a principal place of  
16 business at 3590 Peterson Way, Santa Clara, California 95054.

17               5.     On information and belief, Tessera is a Delaware corporation with its  
18 principal place of business in San Jose, California.

## **JURISDICTION**

6. This Court has jurisdiction over this action, under 28 U.S.C. §§ 1338(a),  
2201, and 2202, because this action arises under the patent laws of the United States, and is based  
upon an actual controversy between ASE and Tessera regarding the non-infringement and  
invalidity of the '106 Patent.

## **VENUE**

25           7.       Venue is proper in this Court pursuant to 28 U.S.C. §§1331(b) and (c). This  
26 district is the principal place of business for both Tessera and ASE (U.S.) Inc.

1               8. Personal jurisdiction and venue over Tessera are proper in this District as  
2 Tessera markets and licenses its patent portfolio within this jurisdiction and has conceded  
3 jurisdiction in concurrent litigation pending before Judge Wilken.

## **FACTUAL BACKGROUND**

5                   9. On September 2, 1997, the United States Patent Office issued the '106  
6 Patent, entitled "Method of Encapsulating Die and Chip Carrier." The '106 Patent states on its  
7 face that Tessera is its assignee. Exhibit A, page 1.

8           10. On August 1, 2008, Tessera informed ASE that Tessera intended to move to  
9 add the '106 Patent to the pending International Trade Commission Investigation entitled *In the*  
10 *Matter of Certain Semiconductor Chips with Minimized Chip Package Size and Products*  
11 *Containing Same (IV), ITC Inv. No. 337-TA-649* ("the 649 Investigation"), alleging that ASE is  
12 infringing the '106 Patent.

13                 11. At present, the parties are involved in two separate cases: the 649  
14 Investigation and a pending patent infringement case in United States District Court in the  
15 Northern District of California, Case No. 05-4063 CW, before the Honorable Claudia Wilken.  
16 Each case has multiple Patents in Suit and concern products similar to those products which  
17 Tessera contends infringe the '106 Patent.

18           12. By reason of the foregoing, there is a justiciable controversy between ASE  
19 and Tessera concerning non-infringement and invalidity of the '106 Patent.

20               13. ASE therefore seeks a Declaratory Judgment from this Court that ASE's  
21 packaging services have not and do not infringe Tessera's '106 Patent, either directly, indirectly,  
22 or otherwise.

23                   14. ASE also seeks a Declaratory Judgment from this Court that Tessera's '106  
24 Patent is invalid.

**FIRST CLAIM FOR RELIEF**

26               15. Plaintiff ASE realleges and repeats the allegations of paragraphs 1-14 as  
27 through fully set forth herein.

1 16. ASE seeks a Declaratory Judgment from this Court, under Fed. R. Civ. P.  
2 57 and 28 U.S.C. §§ 2201 and 2202, declaring the '106 Patent to be not infringed by ASE, and  
3 granting ASE all other declaratory relief to which it may be entitled.

**SECOND CLAIM FOR RELIEF**

5           17. Plaintiff ASE realleges and repeats the allegations of paragraphs 1-16 as  
6 through fully set forth herein.

7               18. ASE seeks a Declaratory Judgment from this Court, under Fed. R. Civ. P.  
8 57 and 28 U.S.C. §§ 2201 and 2202, declaring that the claims of the '106 Patent are invalid for  
9 failing to satisfy one or more requirements of the Patent Statute, including, without limitation, 35  
10 U.S.C. Sections 101, 102, 103, 112, and 282.

## **PRAYER FOR RELIEF**

WHEREFORE, ASE respectfully requests that the Court:

13 A. issue a Judicial Declaration that:

17                   2. The claims of Tessera's United States Patent No. 5,663,106 are  
18 invalid.

19 B. grant any and all equitable relief to which Advanced Semiconductor  
20 Engineering, Inc., ASE Test Limited, and ASE (U.S.) Inc. are entitled;

21 C. award Advanced Semiconductor Engineering, Inc., ASE Test Limited, and  
22 ASE (U.S.) Inc. all other and further relief to which they may be entitled; and

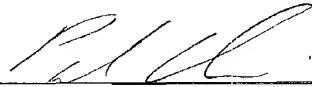
D. order such relief as the Court deems just and equitable.

**JURY DEMAND**

25 Advanced Semiconductor Engineering, Inc., ASE Test Limited, and ASE (U.S.)  
26 Inc. demand a trial by jury of all issues triable of right by a jury.

1 Dated: August 4, 2008

2 THELEN REID BROWN RAYSMAN &  
3 STEINER LLP

4 By 

5 Robert E. Camors, Jr.  
6 Papool S. Chaudhari

7 Attorneys for Plaintiffs  
8 Advanced Semiconductor Engineering, Inc., ASE  
9 Test Limited, and ASE (U.S.), Inc.

10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28